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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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2512	7590	06/13/2005	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			RAMOS FELICIANO, ELISEO	
			ART UNIT	PAPER NUMBER

2687

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,895

Applicant(s)

PIRKOLA ET AL.

Examiner

Eliseo Ramos-Feliciano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Previous objection to the claims is withdrawn in view of applicant's amendment filed January 24, 2005..

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3, 7-12, and 14-22** are rejected under 35 U.S.C. 102(e) as being anticipated by Tuomela et al. (US Patent Application Publication US-2001/0031633-A1).

Regarding **claim 1**, Tuomela et al. discloses a method for establishing and making a check for a communications connection, in which method an electrical communications connection is set up between a calling party and receiving party (Figure 2), in which method before establishing the communications connection proper,

there is a making of a check for the calling party concerning the ability of the receiving party to receive the message (call) sent by the calling party and, ("check context information", see Figure 2, element 2; see also page 1, paragraph 0010)

based on that information, there is making of a decision about the establishment of the communications connection proper. (for example: a decision is made between leaving a message

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for the user, or causing the call to ring the user's phone, see page 1, paragraph 0008, especially the last three lines; and the abstract).

The "context information" indicates a receiving party's activity, place or location and/or environment; see pages 1-2, paragraphs 0015-0016 and 0019.

Regarding **claim 2**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). In addition, Tuomela et al. discloses that the check for the calling party concerning the ability of the receiving party to receive the message (call) of the calling party includes steps of:

dialing the receiving party's number, (Figure 2, element 1)

fetching the activity status data of the receiving party (context information) from an activity log (at WAP context server 7), (Figure 2, element 2; page 1, paragraphs 0009-0010)

presenting possible options of action (page 2, paragraphs 0024-0031) and selecting the best of them ("preferred selection"), (page 2, paragraphs 0022 and 0033)

examining whether the option of action is possible, and (The list presented to the calling party, shown in paragraphs 0026-0031, are "possible" options. It is the calling party who "examines" these options.)

the communications connection proper is established if the option of action is found possible. (If the calling party chooses, for example, "put the call through now", paragraph 0031, then the proper communications connection is established.)

Regarding **claim 3**, Tuomela et al. discloses everything claimed as applied above (see *claim 2*). In addition, Tuomela et al. discloses that the data (context information) representing the activity status of the receiving user are fetched from an activity status server (WAP server 7; Figure 2). (See paragraphs 0009 and 0019.)

Regarding **claim 7**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). In addition, Tuomela et al. discloses that the communications connection proper is a telephone connection (“phone call” - Figure 2, element 1; “incoming call” - abstract, line 4).

Regarding **claim 8**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). In addition, Tuomela et al. discloses that the communications connection proper is a text message (“SMS message”, “e-mail” - paragraph 0036, lines 4-5).

Regarding **claim 9**, Tuomela et al. discloses a communications connection set-up and checking arrangement (Figure 2), comprising a terminal of the calling party (left-side 10, Figure 2), terminal of the receiving party (right-side 10, Figure 2) and an electrical communications connection between the two parties (call), which arrangement further comprises user-specific activity logs (“context information”). (See paragraphs 0009-0010, 0015-0016, 0019, and claim 1 of Tuomela et al.).

Regarding **claim 10**, Tuomela et al. discloses everything claimed as applied above (see *claim 9*). In addition, Tuomela et al. discloses an activity status server (WAP server 7, Figure 2) connected with the user specific activity logs. (See paragraph 0019, and claim 5 of Tuomela et al.).

Regarding **claim 11**, Tuomela et al. discloses everything claimed as applied above (see *claim 10*). In addition, Tuomela et al. discloses that the activity logs are files in the activity status server (Since it is stored in a storage unit it is a “file” as claimed; see paragraph 0009. The WAP-based message is transferred from WAP server 7 to caller’s phone equipment; see paragraphs 0013 and 0008. See also, e.g., claim 10 of Tuomela et al.).

Regarding **claim 12**, Tuomela et al. discloses everything claimed as applied above (see *claim 9*). In addition, Tuomela et al. discloses that the activity log is a file in the terminal of the user (context information is stored in the user's phone. See paragraph 0009, and claim 4 of Tuomela et al. Since it is stored in a storage unit it is a "file" as claimed).

Regarding **claim 14**, Tuomela et al. discloses a cellular network (Figure 3) comprising terminals (MS 10), base stations (BTS 5), base station controllers (BSC 4) and switching centers (MSC 3), which network further comprises an activity status server (WAP SERVER 7) for storing a user-specific activity log. (See paragraphs 0034 and 0019).

Regarding **claim 15**, Tuomela et al. discloses everything claimed as applied above (see *claim 14*). In addition, Tuomela et al. discloses that the activity status server (7) is connected with a switching center (3). (See Figure 3).

Regarding **claim 16**, Tuomela et al. discloses a cellular network terminal (MS 10) comprising a means for entering data (keypad 16) in the terminal, data display means (display 14), data transmission means (transmitter 20), data reception means (receiver 22), memory unit (memory 13) and a control unit (MCU 12), which terminal further comprises an activity status monitoring means (CSU 26). (See Figure 3, paragraphs 0037-0040, and 0015).

Regarding **claim 17**, Tuomela et al. discloses everything claimed as applied above (see *claim 16*). In addition, Tuomela et al. discloses that part of the memory (13) of the terminal can be allocated for creating and maintaining a user-specific activity log ("current context"). (See paragraph 0038).

Regarding **claim 18**, Tuomela et al. discloses everything claimed as applied above (see *claim 16*). In addition, Tuomela et al. discloses that part of a SIM card ("removable SIM"),

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connected with the terminal, can be allocated for creating and maintaining a user-specific activity log (“subscriber-related information”). (See paragraph 0038).

Regarding **claim 19**, Tuomela et al. discloses everything claimed as applied above (see *claim 16*). In addition, Tuomela et al. further discloses means for displaying (14) activity status data for the receiving party fetched from an activity status server (WAP server 7). (See paragraphs 0024-0025 and 0019).

Regarding **claim 20**, Tuomela et al. discloses everything claimed as applied above (see *claim 19*). In addition, the mode or means employed by the user to activate or enable context-sensitive answering read as the claimed “means for making a decision about whether a communications connection proper will be established” because when enabled it “makes a decision about” whether to establish the proper communications connection. (See paragraphs 0016-0017).

Regarding **claim 21**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). The process of creating a context-based data is inherently performed by “software means” or, simply, software (e.g. see “operating program”, paragraph 0038). Which software means is arranged so as to realize the steps of the method according to *claim 1* (explained above).

Regarding **claim 22**, Tuomela et al. discloses everything claimed as applied above (see *claim 21*). In addition, the application program (operating program) is stored on a data transfer medium, in the memory (13) of a terminal, on a SIM card of a terminal, or in a cellular network device. (See paragraph 0038).

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuomela et al. (US Patent Application Publication US-2001/0031633-A1).

Regarding **claim 13**, Tuomela et al. discloses everything claimed as applied above (see *claim 9*). In addition, Tuomela et al. further discloses an user profile editing function (the user can input or “edit” current context information by means of a keypad 16; paragraph 0008, lines 8-10, paragraph 0015, last three lines, paragraph 0040, lines 3-4, and claim 3 of Tuomela et al., inter alia) and an activity status application function (“operating program”, paragraph 0038).

However, Tuomela et al. fails to specifically disclose an activity status decoding function as claimed.

Tuomela et al. teaches that the activity status (current context information) is transferred to the calling party (caller’s phone) in the form of a code that identifies one of a set of animations stored in the caller’s phone for selecting an appropriate one to be displayed to the caller (paragraph 0018, lines 14-18). The animation can depict the current activity of the called party (receiving party), for example, in a meeting, on a train, etc. (paragraph 0018, lines 8-10). Thus, Tuomela et al. suggests “an activity status decoding function” as claimed because the transferred code is matched with an appropriate animation. One advantage of this is that animations can be language independent (paragraph 0018, lines 12-13).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Tuomela et al. with “an activity status decoding function” because it would enable a language independent feature as suggested by the same Tuomela et al.

6. **Claims 4-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuomela et al. (US Patent Application Publication US-2001/0031633-A1) in view of Silverman (US Patent Number 6,035,031).

Regarding **claim 4**, Tuomela et al. discloses everything claimed as applied above (see *claim 2*). However, Tuomela et al. fails to specifically disclose that if the option of action decided upon (e.g. call) is impossible to carry out, there is a step of checking whether the option of action can be carried out later.

Silverman discloses method wherein if the option of action decided upon (call) is impossible to carry out, it is checked whether the option of action can be carried out later (call-back). If the call is impossible to carry out “it is checked whether” a call-back can be carried out later. See column 3, lines 11-30 of Silverman.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Tuomela et al., if the option of action decided upon is impossible to carry out, so as to check whether the option of action can be carried out later, because this would enable the users to communicate in spite of present unavailability of the called party.

Regarding **claim 5**, Tuomela et al. and Silverman disclose everything claimed as applied above (see *claim 4*). However, they fail to specifically disclose that if the option of action can be

carried out later, the data representing the activity status of the receiving party are fetched again after a time delay.

Silverman discloses to perform the call-back within a time delay (timer value); see column 3, lines 30-50. The call-back includes making a phone call to the called party (receiving party); column 3, lines 61-62.

Tuomela et al. discloses that upon a phone call (Figure 2, element 1 of Tuomela et al.), the activity status (context information) of the receiving party are fetched (Figure 2, element 2 of Tuomela et al.). Which in combination with Silverman's call-back is "fetched again after a time delay".

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Tuomela et al., if the option of action can be carried out later, so that the data representing the activity status of the receiving party are fetched again after a time delay, because this would provide the calling party with updated information about the called party since the time elapsed from the first original call to a second successful call can be significant.

Regarding **claim 6**, Tuomela et al. and Silverman disclose everything claimed as applied above (see *claim 4*). However, Tuomela et al. fails to specifically disclose that if the option of action decided upon cannot be carried out after a time delay, a communications connection proper is not established.

Silverman further discloses that if the option of action decided upon (call-back) cannot be carried out after a time delay (timer value), a communications connection proper is not established. For example, the call-back timer value can be set to 30 minutes. If the timer value

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expires the call-back is terminated and the communications connection proper is not established.

See column 3, lines 35-45 of Silverman.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Tuomela et al., if the option of action decided upon cannot be carried out after a time delay, so that a communications connection proper is not established, because the wait is too long after the time delay (timer) expires.

Response to Amendment

7. The declaration filed on January 24, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Tuomela et al. reference.

According to MPEP 706.02(a) and 706.02(f)(1) Tuomela et al. is available as prior art under 35 U.S.C. 102(e) as of December 1, 1999 because it is an earlier US filing date for which priority or benefit is properly claimed. The declaration filed under 37 CFR 1.131 fails to address the December 1, 1999 date; rather concentrates on November 30, 2000. Consequently, the declaration has been considered but is moot in view of what has been explained. Applicant is referred to MPEP 715 for guidelines on the proper filing of a declaration under 37 CFR 1.131.

Response to Arguments

8. Applicant's arguments filed January 24, 2005 have been fully considered but they are not persuasive.

9. Applicant argues that the declaration filed on January 24, 2005 under 37 CFR 1.131 overcomes the Tuomela et al. reference (see pages 8-11 of the response; particularly page 10, fourth paragraph).

In response, as explained above, the declaration has been considered but is ineffective to overcome the Tuomela et al. reference because Tuomela et al. is available as prior art under 35 U.S.C. 102(e) as of December 1, 1999 and the declaration fails to address this date. The declaration has been considered but is moot as explained above.

10. Applicant argues that an English translation of the Finish patent application has been filed at the USPTO (see page 10, second paragraph of the response).

In response Applicant is advised that Official records fail to show an English translation of the Finish patent application being filed before the USPTO. Official records show the filing on February 25, 2002 of a Certified Copy of the Finish patent application number 20002814, not the corresponding English translation. Applicant is advised to submit copy of mailing receipt along with a copy of the English translation. Applicant is referred to MPEP 706.02(b) for guidelines on perfecting a claim to priority under 35 U.S.C. 119(a)-(d).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

12. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERF/erf
June 9, 2005


ELISEO RAMOS-FELICIANO
PATENT EXAMINER